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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/088,598

03/21/2002

Akio Yamane

2002-0401A

6872

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7590

01/13/2005

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

SAKELARIS, SALLY A

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/088,598

Applicant(s)

YAMANE, AKIO

Examiner

Sally A. Sakelaris

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3, 5-9.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Sally A. Sakelaris
1/11/05

JEFFREY FREDMAN
PRIMARY EXAMINER

1/11/05

Continuation of 2. NOTE: The proposed amendments will not be entered. Specifically, applicant should note that their amendment to claim 1 presents a new limitation that raises new issues that would require further consideration and search. Applicant's amendment, "thereby resulting in no quenching of the labeling substance" extensively modifies the claim and as a result will not be entered. While applicant in their response assert that "the new wording has substantially the same meaning as the old", it is clear from applicants own arguments that the change is substantial enough to overcome the standing rejection made over the prior art. Therefore the recitation of "no quenching" raises new issues that would require further consideration and search.

Continuation of 5. does NOT place the application in condition for allowance because: The applicant's amendment to claim 1 will not be entered as it would require further search and consideration. In addition, the applicant's traversal on the grounds that Livak "neither discloses nor suggests that a quencher molecule binds to or intercalates to a double-stranded nucleic acid or that the fluorescence of the reporter molecule is thereby unquenched". However, as stated in the final rejection, this limitation is not in the claims as presently written and furthermore there is no requirement in the claim for the ordered sequential steps of hybridization, intercepting, and quenching to occur which applicant argues in their response. Furthermore, the fact that the Livak probe includes a conformational change is irrelevant considering the claim does not preclude such an embodiment and further that Livak is able to anticipate the limitations of the claims as presently written.

Furthermore, the remaining rejections are also maintained for reasons of record in view of the non-entry of after final amendment.